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Paper No. 11

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APR 12 2002

OFFICE OF PETITIONS

In re Application of :
Frank J. Giordano et al. :
Application No. 09/847,936 :
Filed: May 3, 2001 :
Attorney Docket No. 220002057125 :

ON PETITION

This is in response to the petition under 37 CFR 1.47(a), filed February 25, 2002.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks item (1) set forth above.

By declaration of attorney Catherine M. Polizzi, applicants set forth the facts relied on to conclude that inventor Frank J. Giordano refuses to join in the application. Attorney Polizzi detailed unsuccessful attempts to contact inventor Giordano by email and telephone, as well as, delivery of an assignment and declaration to inventor Giordano's last known business address via Federal Express on February 5, 2002 and February 11, 2002. In support of the petition, applicant submitted a copy of the Federal Express confirmation of deliveries.

The evidence presented fails to show that a complete copy of the application papers for this case was presented to nonsigning inventor Giordano. Before a refusal can be alleged, applicants must demonstrate that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. If joint inventor Giordano was not presented with a copy of the application papers, then Mr. Giordano could not attest that he has "reviewed and understands the application papers" and could not execute that declaration he was requested to sign. Therefore, unless petitioner can show that a copy of the application papers was presented to inventor Giordano, then petitioner will have to mail a copy of the complete application papers (specification, claims and drawings) to inventor Giordano's last known address, return receipt requested. A cover letter of instructions should accompany the mailing of the application papers setting a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. The proof of the pertinent events should be made by a statement of someone with firsthand knowledge of the events and should include documentary evidence, such as certified mail return receipt, cover letter of instructions, telegram, etc. See Manual of Patent Examining Procedure, Section 409.03(d).

The assignment and declaration sent by Federal Express to the last known address of inventor Giordano were not signed for by inventor Giordano, but by "Y. Haung" and "M. Chirloski." Therefore, it is likely from the evidence submitted that the address to which applicant sent the documents, may be invalid. Further efforts to locate inventor Giordano and to present the application papers to him at a valid address (or establish that the address to which the papers were delivered is valid) are warranted. If diligent efforts to obtain a forwarding address or to locate the non-signing inventor by other means such as through the Internet continue to fail, then applicant will have provided the necessary proof required under 37 CFR 1.47 that the inventor cannot be reached. Applicant should submit documentary evidence such as the results of a telephone directory or an Internet search. However, if the non-signing inventor is located at another address, a copy of the application papers should be sent to him at that address, or, if it is determined that the inventor is represented by counsel, to the address of the non-signing inventor's attorney. Documentary evidence, including copies of the transmittal cover letters and return mail receipts, should be made part of the record.

In order to expedite consideration of the petition under 37 CFR 1.47(a), petitioner may wish to submit the renewed petition by facsimile transmission to the telephone number indicated below and to the attention of Irvin Dingle.

Further correspondence with respect to this matter should be addressed as follows:

By mail: U. S. Patent and Trademark Office
Mail Stop DAC, P.O. Box 2327
Arlington, VA 22202

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA 22202

Telephone inquiries related to this decision should be directed to Irvin Dingle at (703) 306-5684.



Frances Hicks

Lead Petitions Examiner
Office of Petitions
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for Patent Examination Policy